REMARKS/ARGUMENTS

In response to the Office Action dated June 11, 2003. Claims 1, 2, 15, 22, 23 29, 35, 52, 53 and 56 are now active in this application. No new matter has been added.

The indication that claim 35 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

CLAIMS 20 AND 30

Claim 20 is listed on the PTO-326 as being both withdrawn from consideration and as being rejected. As the body of the office action makes no mention of claim 20 being rejected or allowable, it is presumed claim 20 is withdrawn from consideration.

Claim 30 is not listed on the PTO-326, and had never been designated canceled. Consequently, claim 30 is pending and is presumed withdrawn from consideration.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 1, 2, 15, 22, 23, 29, 30, 52, 53 and 56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koizumi et al. (USPN 5,287,204) in view of Goto (USPN 5,748,801). The Examiner contends that Koizumi et al. discloses the claimed features, including using a predetermined L* threshold to determined the color pixel. However, the Examiner admits that Koizumi et al. does not specifically mention the threshold is determined based on the extracted brightness. Goto is relied upon as disclosing, in an analogous environment, extracting the brightness and setting the threshold of color pixel based on the brightness.

The rejections are respectfully traversed.

In imposing a rejection under 35 U.S.C. § 103, the Examiner is charged with the initial burden of identifying a source in the applied prior art for: (1) claim limitations; and (2) the requisite motivation to combine references with a reasonable expectation of achieving a specific result. ***Smiths Industries Medical Systems v. Vital Signs***, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). That burden has not been discharged.

Means for determining a reference value based on extracted brightness data, which is a characteristic feature of the present invention, is disclosed at page 36, lines 9-13 of the specification and in Fig. 12. According to embodiments of the present application, a reference value is determined by brightness data using a table that makes brightness data relate to threshold (reference value). From this aspect, it is apparent that determined brightness data itself univocally determines threshold.

On the other hand, as described at column 1, lines 11-19 of Goto, the reference relates to methods of setting threshold values for pixel values of an image when a particular region, such as bones or internal organs of a body to be examined, is extracted from a CT image and, in particular, to a method of setting threshold values for extracting image data in which the set threshold values can be decided to be proper, or not, in real time. It is described that a region to be displayed in full-color and a region to be displayed in monochrome are classified by making comparison of luminance data with a threshold value.

However, in Goto, a threshold value is set by an operator with a mouse 6. For example, from column 5, line 54 to column 6 line of Goto, it is described that an operator can set an optimum threshold value ***with the mouse 6*** observing an image that changes on a display. That is, an operator can input an appropriate threshold value while judging whether or not a threshold value set for an image on the display is appropriate in real time.

Accordingly, Goto does not disclose "determination means for determining a threshold value based on a value of brightness data".

Furthermore, it is also well established in MPEP § 2143.01, last paragraph that the proposed modification cannot change the principle of operation of a reference. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims prima facie obvious." Clearly, the principle operation of a patent is limited by its claims; i.e., the claims delineate the metes and bounds of the invention.

Koizumi et al. specifically claims "...judging a pixel color of each pixel based upon the luminance data and the color different data..." (see claim 1). There is no disclosure or suggesting about using extracted brightness data for determining a reference value for judging a pixel color of each pixel. As noted above, Goto does not disclose "determination means for determining a threshold value based on a value of brightness data". However, even if it were ***presumed*** that Goto discloses extracting the brightness and setting the threshold of color pixel based on the brightness, if Koizumi et al. were modified to use this (presumed) teaching of Goto, it would alter the invention that is claimed in Goto, which is not permitted.

Clearly, the only apparent motivation of record for the modification proposed by the Examiner to arrive at the claimed inventions is found in Applicants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. ***Panduit Corp. v. Dennison Mfg. Co.***, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

It should, therefore, be apparent that the Examiner did not establish a *prima facie* basis to deny patentability to the claimed invention 35 U.S.C. § 103 for want of the requisite realistic

motivational element and/or for want of the requisite factual basis. Thus, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. § 103. ***In re Piasecki***, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Accordingly, withdrawal of the Examiner's rejection of claims 1, 2, 15, 22, 23, 29, 30, 52, 53 and 56 under 35 U.S.C. § 103 is respectfully solicited.

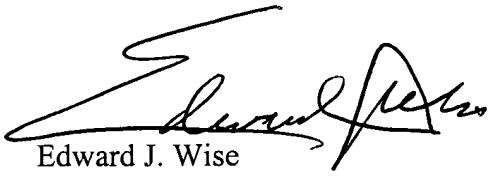
CONCLUSION

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY



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